

REMARKS

By this Office Action, the Examiner has required restriction to one of the following groups of Claims under 35 U.S.C. § 121:

- Group I: claims 1-24 and 49, drawn to an isolated nucleic acid encoding a calcium sensing receptor, the protein encoded thereby or a portion thereof, and a method of using the claimed nucleic acid to produce the claimed protein, classified in class 435, subclass 69.1, class 530, subclass 350 and class 536, subclass 23.5;
- Group II: Claims 25 to 29, drawn to a receptor assay employing a recombinant cell, classified in class 435, subclass 72.1;
- Group III: Claims 30 to 33, drawn to a method of treatment by administering a compound of unspecified constitution, classification undeterminable;
- Group IV: Claims 34 to 40, 47 and 48, drawn to a method of gene therapy, classified in class 514, subclass 44; and
- Group V: Claim 50, drawn to an antibody which binds to a structurally undefined polypeptide, classified in class 530, subclass 388.22.

In the action, the Examiner has asserted that the Claims of Groups I to V do not relate to a single general inventive concept under PCT Rule 13.2 because, under PCT Rule 13.2, they lack the same or corresponding technical features. In particular, it is the position of the Examiner that the process of the Claims of Group II is a process which can employ a product of the Claims of Group I, but is not limited thereto. Hence, the Examiner believes the Claims of Group II do not share a corresponding special technical feature with the Claims of Group I.

Moreover, the Examiner has asserted the compound employed in the Claims of Group III is presumably structurally unrelated to either the protein or nucleic acid of the Claims of Group I and, therefore, the protein and nucleic acid of the Claims of Group I and the compound employed in the Claims of Group III lack a corresponding technical feature.

In addition, the Examiner has asserted the process of the Claims of Group IV employs neither the protein or the nucleic acid of the Claims of Group I and, therefore, allegedly lacks a corresponding technical feature with the Claims of Group I. Hence, the Examiner has asserted that the Claims of Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, in the Examiner's opinion, under PCT Rule 13.2, they lack the same or corresponding special technical features.

In response, solely to be responsive to the requirement for restriction, Applicants provisionally elect, WITH TRAVERSAL, to prosecute the invention of Group I, Claims 1-24 and 49, drawn to an isolated nucleic acid encoding a calcium sensing receptor, the protein encoded thereby or a portion thereof, and a method of using the claimed nucleic acid to produce the claimed protein, classified in class 435, subclass 69.1, class 530, subclass 350 and class 536, subclass 23.5. Furthermore, Applicants respectfully request reconsideration of the Restriction Requirement, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of claims designated by the Examiner in the present application, for reasons provided as follows:

Under 35 U.S.C. § 121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term

"distinct" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions¹, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the Examiner has failed to define compositions and methods for using such compositions with properties so distinct as to warrant separate examination and search. In particular, the Examiner has classified the Claims of Group I in class 435, and has also classified the Claims of Group II, drawn to a receptor assay employing a recombinant cell, in class 435. Thus, the Examiner has failed to note separate classifications for each of these groups of Claims. Consequently, other than the Examiner's opinions, no evidence has been provided that conjoint search and examination of the Claims of Groups I and II can be made without serious burden to the Examiner.

In addition, it is respectfully submitted that PCT rule 13.1 states that 'The international application shall relate to one invention only or to a *group of inventions* so linked as to form a

¹ Applicants in no way admit these Groups of Claims are drawn to patentably distinct inventions

single general inventive concept ("requirement of unity of invention") (emphasis added).'

However, as explained above, the Examiner has admitted that the Claims of Groups I and II fall into the same classification, and consequently are linked.

In light of the above, Applicants respectfully submit that the search and examination of the entire Application, or, at least, of Group I together with Group II, can be made without a serious burden to the Examiner. Hence, the Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit the conjoint examination and inclusion of all the Claims of the present Application, or at least the conjoint examination of the Claims of Groups I and II would not present an undue burden on the Examiner. Accordingly, withdrawal of the Requirement for Restriction, or, at least, modification to permit the conjoint examination of the Claims of Group I and the Claims of Group II is respectfully requested.

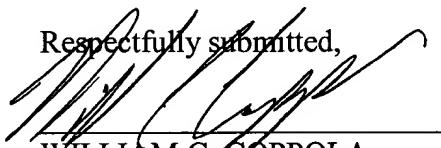
Fees

No additional fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 18-1982 for any underpayment, or credit any overages.

CONCLUSION

In view of the above, early action on the merits is courteously solicited.

Respectfully submitted,



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